IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Gardella *et al.*

Appl. No. 09/475,158

Filed: December 30, 1999

For: **PTH Functional Domain Conjugate Peptides, Derivatives Thereof and Novel Tethered Ligand-Receptor Molecules**

Art Unit: 1646

Examiner: Andrews, J.

Atty. Docket: 0609.4780001/SRL/M-G

Reply To Requirement For Restriction Election

Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office Action dated September 28, 2001, Applicants hereby provisionally elect with traverse the claims of Group I (claims 1-5, 13 and 37, drawn to the polypeptide of SEQ ID NO: 1). This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

Applicants respectfully request that a new restriction requirement be issued. MPEP 803 (August 2001, page 800-4) sets out the criteria for restriction between patentably distinct inventions: the inventions must be independent or distinct as claimed; ***AND*** there must be a serious burden on the Examiner if restriction is required. In the present situation, Applicants respectfully assert that any election made by Applicants will necessitate the breaking apart of a single invention, not the choice of independent or distinct inventions. It is respectfully submitted that the present restriction requirement forces Applicants to change the claims in such a manner as to no longer reflect what Applicants regard as their invention. It is not possible to examine the invention as presently claimed if any of these groups are elected. For example, (peptide1)-

(linker)-(peptide2) of claim 1 (from which claims 2-16 depend) is not a divisible unit. By requiring Applicants to chose a group of claims directed to either one of the possible species of peptide1, or one of the possible species of peptide2, the Examiner would be improperly requiring Applicants to limit their claims.

Even if there were independent or distinct inventions, which is not the case, MPEP 803 clearly states that restriction is proper only if the examination of these independent or distinct inventions places a serious burden on the Examiner. However, all the claims of Groups I-XXI, XL, XLII-XLV and LII can be examined without serious burden on the part of the Examiner because they are classified in the same class and subclass, i.e. class 530, subclass 350. Search of the claims of group I should find art relevant to the claims of any other group. Any additional search that would be needed would not be an undue burden on the Examiner. Further, such information would also be useful in determining the patentability of all the additional groups of claims. Therefore, Applicants respectfully request that the claims of Groups I-XXI, XL, XLII-XLV and LII be grouped together.

In telephone conversations between Applicants' representative and Examiner Eyler, Examiner Eyler indicated that claim 1 is a good example of a linking claim, and that Applicants should traverse the restriction requirement on this basis. However, Applicants respectfully point out that MPEP 809 (August 2001, page 800-48) states that "[w]here linking claims exist, a letter including a restriction requirement only or a telephoned requirement to restrict....will be effected, ***specifying which claims are considered to be linking***" (emphasis added). Therefore, Applicants respectfully request that a new restriction requirement be issued, in which the Examiner specifies which claim(s) she considers to be linking so that Applicants have an opportunity to respond.

It is believed that extensions of time are not required, beyond those that may otherwise be provided for in accompanying documents. However, in the event that additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required therefor are hereby authorized to be charged to our Deposit Account No. 19-0036. A duplicate copy is enclosed.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Steven R. Ludwig
Attorney for Applicants
Registration No. 36,203

Date: 1/28/02

1100 New York Avenue, N.W.
Suite 600
Washington, D.C. 20005-3934
(202) 371-2600

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